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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/305,586	05/05/99	HAGE	589.015US1

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EXAMINER

JOHNSTONE, A

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
**09/305,586**

Applicant(s)  
**Hage**

Examiner  
**Adrienne Johnstone**

Group Art Unit  
**1733**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) 17-20 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 and 21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16 and 21, drawn to a process for manufacturing laminated polymeric elements, classified in class 156, subclass 247.
  - II. Claims 17-20, drawn to a polymeric ophthalmic lens blank, classified in class 351, subclass 159.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which the coating is not removed and/or the blank is not laminated to another optical element or one in which the blank is molded and coated with the film simultaneously.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation between Examiner Scott Sugarman and Mark Litman on September 22, 2000 a provisional election was made with traverse to prosecute the invention of

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Invention I, claims 1-16 and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Information Disclosure Statement***

5. In the Information Disclosure Statement filed August 21, 2000 applicant states that the references cited therein were also cited in a communication from a foreign patent office in a counterpart application, however applicant did not submit a copy of the communication (which is typically a search report indication the degree of relevance of each reference). The examiner hereby requests a copy of this communication.

### ***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the subject matter of claim 16 does not appear to be recited in the specification.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To provide proper antecedent basis and Markush groups and to eliminate vague language applicant should make the following amendments to the claims.

**claim 1**

line 4, before "solvent dispersible" insert -- first -- .

**claim 2**

line 2, change "comprise" to -- are -- .

**claim 3**

lines 1-2, change "comprises an aqueous liquid" to -- is water or an aqueous solution -- .

**claim 4**

lines 1-2, change "comprises an aqueous liquid" to -- is water or an aqueous solution -- .

**claim 8**

line 3, before "solvent-soluble" insert -- first -- and before "solvent dispersible" insert -- first -- .

**claim 9**

lines 1-2, change "polymeric coating composition is selected from compositions comprising polymers" to -- film comprises a polymer -- ;

line 3, change "poly vinyl resins" to -- polyvinyl polymers -- .

**claim 10**

line 1, change "polymeric coating composition" to -- film -- .

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**claim 11**

line 1, change "comprises" to -- is -- .

**claim 12**

lines 1-2, change "polymeric coating composition is selected from compositions comprising polymers" to -- film comprises a polymer -- ;

line 3, change "poly vinyl resins" to -- polyvinyl polymers -- .

**claim 13**

line 1, change "polymeric coating composition" to -- film -- .

**claim 14**

line 1, change "comprises" to -- is -- .

**claim 15**

line 2, change "lens" to -- first polymeric optical element -- .

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector et al. (5,883,169) cited by applicant.

and 21

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The only difference between the Spector et al. method and the claimed method is that the temporary protective film is removed by peeling rather than dissolving or dispersing with a solvent that does not attack the polymeric optical element (Spector et al. entire document), however a conventional alternative technique for removing temporary films from polymeric ophthalmic lenses is removal by dissolving or dispersing the film with such a solvent, such as water or an aqueous solution. It would have been obvious to one of ordinary skill in the art to employ such a conventional alternative technique for removal of the temporary protective film in the Spector et al. '169 method. As to claims 9-14, it would have been obvious to one of ordinary skill in the art to select for the film in the above method any conventional polymer material capable of dissolving or dispersing in the water or aqueous solution.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne Johnstone whose telephone number is (703) 308-2059. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

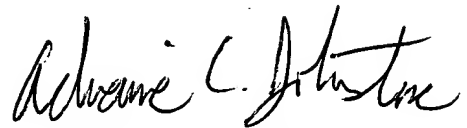
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 for official after final faxes and (703) 305-7718 for all other official faxes.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Adrienne Johnstone

September 28, 2000

A handwritten signature in black ink, reading "Adrienne C. Johnstone". The signature is written in a cursive style with a large, stylized 'A' and 'J'.

**Adrienne Johnstone**

**Primary Examiner**

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